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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,098	02/26/2002	Arthur D. Gershowitz	032722-594	8586

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Platon N. Mandros, Esq.  
BURNS, DOANE, SWECKER & MATHIS, L.L.P.  
P.O. Box 1404  
Alexandria, VA 22313-1404

EXAMINER

DESANTO, MATTHEW F

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/082,098

Applicant(s)

GERSHOWITZ, ARTHUR D.

Examiner

Matthew F DeSanto

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-6, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 4-6, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Dye et al. (USPN 3,742,960)

Dye et al. discloses a retrograde cannula comprising a body with a proximal and distal end, and an infusion lumen extending therebetween, an automatically inflatable balloon, a valve arranged in the body and a drainage lumen, wherein the passage arrangement constitutes the sole means of delivering inflation fluid to the balloon.  
(Figures 1, and entire reference)

2. Claims 1, 4-6, 18, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Finney.

Finney discloses a retrograde cannula comprising a body with a proximal and distal end, and an infusion lumen extending therebetween, an automatically inflatable balloon, a valve arranged in the body and a drainage lumen, wherein the passage arrangement constitutes the sole means of delivering inflation fluid to the balloon.  
(Figures 1, 3, and Column 1, lines 36-Column 3, lines 10)

3. Claims 1, 4-6, 18, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Lafontaine et al. (USPN 5,695,468).

Lafontaine et al. discloses a retrograde cannula comprising a body with a proximal and distal end, and an infusion lumen extending therebetween, an automatically inflatable balloon, a valve arranged in the body and a drainage lumen, wherein the passage arrangement constitutes the sole means of delivering inflation fluid to the balloon (Col. 10, line 1 – Col. 12, line 30).

4. Claims 1, 4-6, 18, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by DiCaprio et al. (USPN 6,176,843)

DiCaprio et al. discloses a retrograde cannula comprising a body with a proximal and distal end, and an infusion lumen extending therebetween, an automatically inflatable balloon, a valve arranged in the body and a drainage lumen, wherein the passage arrangement constitutes the sole means of delivering inflation fluid to the balloon (Column 4, line 31 – Column 5, line 60).

#### ***Response to Arguments***

5. Applicant's arguments and amendments filed 4/20/04 have been fully considered but they are not persuasive, with regards to Dye et al.

6. Dye et al. has the same structure as the applicant's invention, the only difference is the intended use of the Dye et al. Dye et al. has a valve used for closing off the lumen and maintaining pressure in the balloon as well as an aperture to allow fluid to pass through the aperture, and a drainage lumen. (Figure 1 and 2). The amendment made in the last reply does not impose any structure or element that is different than the prior art. Since this is an apparatus claim, the structure is the main patentable subject matter. Therefore, the examiner concludes that Dye et al. could be used as an infusion

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catheter since all the structure is the same as the applicant's catheter and that a person of ordinary skill would use the catheter in that manner. The examiner cites case law to further support his argument and wants too drawn the attention of the applicant to MPEP section 2114.

7. In response to applicant's argument that of intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F DeSanto whose telephone number is 1-703-305-3292. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 1-703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew DeSanto  
Art Unit 3763  
August 5, 2004



**BRIAN L. CASLER**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**